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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,870	08/09/2001	Dieter Busch	741124-77	3696

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EXAMINER

GUADALUPE, YARITZA

ART UNIT PAPER NUMBER

2859

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/924,870

Applicant(s)

BUSCH ET AL.

Examiner

Yaritza Guadalupe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 8, drawn to process for determining the alignment of a body, classified in class 33, subclass 529.
  - II. Claims 9 - 16, drawn to a device for determining the alignment of a cylindrical body, i.e. printing press, classified in class 101, subclass 216.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand such as one process that does not require the use of an evaluation means.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. David Safran on October 9, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 - 8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9 - 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1 – 6 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Murray Jr. (US 5,077,905).

Murray discloses an alignment assembly and method for aligning including a position measurement assembly / probe which is calibrated ( See Column 10, lines 43 – 52 ) to a reference direction, attached to an end face or a surface essentially parallel to an end face of the body to be align ( See Figure 2 ), and also including the steps of performing position measurements in at least three measurement positions in a 360° range of the angle of rotation and wherein the difference between rotation is approximately 90° ( See Column 12, lines 12 – 25 ). Murray further discloses a computing the alignment of the body with respect to the reference direction from the measured data gathered from the at least three measurement positions ( See Columns 12 – 14 ). Murray discloses the alignment of the body being computed using optimization processes that includes compensation computation from the position data gathered.

Murray clearly discloses the measurement assembly rotated in 90° angles of the longitudinal axis / lengthwise axis of the body or roll angle, the measurement range of rotation being perpendicular to one another and the measurement assembly being attached to the body such that the roll angle measurement indicates revolution of the probe around an axis parallel to the axis of the body.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103 ( a ) as being unpatentable over Murray Jr. ( US 5,077,905 ).

Murray discloses an alignment device and method as stated in paragraph 7 above.

Murray does not disclose the measurement probe being an optical gyro as stated in claim 7.

Regarding claim 7 : Murray discloses a device having a position measurement assembly comprising a laser arrangement. The use of the particular type of position measurement probe claimed by applicant, i.e., optical gyro, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the position information is measured and recorded, as

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already suggested by Murray, 2) the position measurement probe claimed by Applicant and the position measurement assembly used by Murray are well known alternate types of position measurements probes which will perform the same function, if one is replaced with the other, of measuring and recording position information, and 3) the use of the particular type of position measurement probe by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of position measurement probes that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to measure and record position information as already suggested by Murray.

10. Claim 8 is rejected under 35 U.S.C. 103 ( a ), as being unpatentable over Murray Jr. ( US 5,077,905 ) in view of Woyton ( US 4,553,335 ).

Murray discloses an alignment device and method as stated in paragraph 7 above.

Murray does not disclose the probe being attached by means of magnetic forces as stated in claim 8.

With respect to claim 8 : Murray discloses an alignment having a position measurement assembly attached to the body by means of a screw ( 27 ). Woyton discloses an alignment device comprising a magnet ( 68 ) for securing the device to the body. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the securing means, i.e., screw, disclosed by Murray with the magnetic securing means disclosed

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by Woyton in order to provide an attaching means that securely attaches the assembly to a body and also allows for easy removal / relocation without the use of additional tools in order to do so.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saunders ( US 5,056,237 ) discloses a device for aligning comprising measuring position information distributed in angles of rotation of approximately  $90^{\circ}$  over the range of  $360^{\circ}$  ( See Abstract ) and computing the alignment ( See Column 5, lines 61 – 68 ). Hinkle et al. ( US 6,411,375 ) discloses an alignment method comprising the step of measuring positions over the range of rotation of  $360^{\circ}$  ( see Column 7, lines 11 – 21 ).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9318 for regular communications and (703)872-9319 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Yaritza Guadalupe  
Patent Examiner  
Art Unit 2859  
October 29, 2002

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